



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,200	08/07/2000	Michael C. Kiefer	4147-7-1DIV4	3491

7590 02/13/2002  
Theresa A Brown  
Sheridan Ross PC  
Suite 1200  
1560 Broadway  
Denver, CO 80202-5141

EXAMINER

HUNT, JENNIFER ELIZABETH

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/633,200

Applicant(s)

KIEFER ET AL.

Examiner

Jennifer E Hunt

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-38 and 59-65 is/are pending in the application.
- 4a) Of the above claim(s) 33-38, 64 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 32 and 59-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the search for one group would be required for the other group. This is not found persuasive because as set forth in the previous office action, the searches are not coextensive.

The requirement is still deemed proper and is therefore made FINAL.

2. Acknowledgement is made of applicant's addition of new claims 59-65. Claims 32-38 and 59-65 are pending in the application. Claims 33-38 and 64-65 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 32 and 59-63 are addressed herein.

***Information Disclosure Statement***

3. The Information Disclosure Statement (PTO-1449) filed 3-19-2001 is acknowledged; however, copies of the references cited as available in parent case 08/320,157 are not in that case. The examiner is making efforts to locate these references; however, resubmission of these documents, if possible, by applicant would facilitate their consideration and would be greatly appreciated by the examiner. A signed copy of the PTO-1449 will be mailed as soon as the examiner obtains copies of the references.

Art Unit: 1642

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 60 is improper because it is dependent from a rejected claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 32 and 59-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Chittenden, US Patent 5,672,686, as evidenced by Cruse and Lewis, Illustrated Dictionary of Immunology, 1994, page 241.

Figure 4 (SEQ ID NO:16 and 17) teaches the cDNA and deduced amino acid sequence of Bcl-Y, which shares high homology and functionality with the instantly recited SEQ ID NO's 9, 21, and 22 (see figure 4 of 5,672,686, and the corresponding enclosed alignments.) 5,672,686 also teaches polyclonal and monoclonal antibodies which bind Bcl-Y, specifically SEQ ID NO:16 (see for example, column 20, line 51-column 26, line 20, and the claims). While the amino acid sequence of SEQ ID NO:16 in 5,672,686 and the instantly recited SEQ ID NO's 9, 21, and 22 are not identical, they are sufficiently similar such that an antibody which bound to one would be expected to bind to the other.

This is because it is known in the art that the number of antigenic determinants on a protein is very large, and often encompasses large regions of the protein (see Walter, Journal of Immunological Methods, Vol. 88, pages 149-161, 1986, page 151, column 2). Thus proteins which have similar primary structure and similar function (and thus likely similar conformations) would be expected to present similar epitopes and thus numerous antibodies which bind to one would be expected to bind to another. Further with regard to polyclonal antibodies, encompassed by claims 32, 59, and 61-62, polyclonal antibodies are known to be widely reactive with a multiplicity of epitopes. (see for example, Cruse and Lewis, Illustrated Dictionary of Immunology, 1994, page 241.)

***Allowable Subject Matter***

Art Unit: 1642

8. Claim 60 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E Hunt whose telephone number is (703) 308-7548. The examiner can normally be reached on Monday-Friday, 6-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

Jennifer E Hunt  
Examiner  
Art Unit 1642

jeh  
February 11, 2002

  
SHEELA HUFF  
PRIMARY EXAMINER